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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/908,697	07/20/2001	Kazutaka Matsueda	35.G1362 D	1944

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EXAMINER

GARCIA, GABRIEL I

ART UNIT	PAPER NUMBER
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2624

DATE MAILED: 01/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/908,697

Applicant(s)

Matsueda et al.

Examiner

H. Garcia

Art Unit

2624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 10/29/02.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 23-27 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 23-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f):
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**Part III DETAILED ACTION**

1. This office action is in response to the amendment filed on 10/29/02. Claims 23-27 are pending in this application.

***Double Patenting***

2. The claims 23-27 are still rejected under the judicially created doctrine of the obviousness type double patenting of the claim(s) in applicant's prior United States Patent No. 6,301,016. Although the designs are not identical, they are not patentably distinct from each other because both the pending claim of this application and the claim(s) of United States Patent No. 6,301,016 contain: an input unit adapted to input data (reads on the means for inputting data of United States Patent No. 6,301,016; an identification unit (reads on the means for detecting of United States Patent No. 6,301,016; a transfer unit (reads on the means for transferring of United States Patent No. 6,301,016); and a generation unit to notify the user (reads on the transmitter to transmit report information to a user of United States Patent No. 6,301,016). Claim 27 of the present application reads on the claim(s) of United States Patent No. 6,301,016. The obviousness type double patenting rejection is a judicially established doctrine based on public policy, and is primarily

intended to prevent prolongation of monopoly by prohibiting a claim in a second patent not patentably distinguishable from a claim in a first patent.

A timely filed terminal disclaimer will obviate this rejection. (MPEP § 1490) *In re Vogel*, 164 USPQ 619 (CCPA 1970).

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371<sup>6</sup> of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 23-27 are rejected under 35 U.S.C. 102(e) as being anticipated by Ueno (5,978,097).

With regard to claim 23, Ueno teaches a data processing apparatus (fig. 1) connectable to a LAN (reads on fig. 1, item labeled NCU, which is the network connection to other output devices), comprising: an input unit (10 or 20) adapted to input data (through the scanner or the network connection); an identification unit adapted to (reads on the NCU which identifies the call as described on step #12 of fig. 2, which detect when a call is made to the data processing apparatus); a transfer unit (reads on fig. 2, step #32) adapted to transfer the data inputted by said input unit to a terminal connected to the LAN (e.g. col. 2, lines 56-65 and col.4); and a generation unit adapted to generate a predetermined signal to notify the user that the data has been transferred by said transfer unit (reads on fig. 2 and col. 4, lines 9-60, which notifies the user that the data has been transferred to another device or terminal).

With regard to claim 24, Ueno further teaches a storage unit adapted to store information used to discriminate to which terminal the data is transferred by said transfer unit (e.g. col. 4, lines 38-60).

With regard to claim 25, Ueno further teaches the transfer unit transfers the data inputted by said input unit when a printer for printing the data is in an error state (reads on col.

4, line 9 thru col.5, line 51, the printer reads on the facsimile machine, which acts as a printer).

With regard to claims 26 and 27, the limitations of claims 26 and 27 are covered by the limitations of the claims 23-25 above, which teach the means and the steps to produce the limitations of claim 26. The steps described above, can be program and stored in the memory (36) of the apparatus of Ueno to produce the process code as claimed by claim 27.

#### **Conclusion**

5. Applicant's arguments with respect to newly added claims have been considered but are moot in view of the new ground(s) of rejection. Newly added features have been addressed above.


6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is

not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Gabriel I. Garcia** whose telephone number is (703) 305-8751. The examiner can normally be reached Monday-Thursday from 7:30 AM-6:00 PM. The fax phone number for this group is (703) 872-9314.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 306-0377.

  
Gabriel I. Garcia  
Primary Examiner  
January 10, 2003

GABRIEL GARCIA  
PRIMARY EXAMINER